

## **REMARKS**

### **I. INTRODUCTION**

Claims 1-17, 19, and 20 are pending in the application. By this Amendment, independent claims 1 and 10 are amended to more clearly recite the features of the measuring device and measuring method, respectively, for testing the cut quality of a sheet and to better conform to U.S. standards. All of the dependent claims are similarly amended to better conform with standard U.S. practice. Claim 18 is canceled without prejudice or disclaimer and Applicant expressly reserves the right to pursue the scope of subject matter recited therein in related continuation and/or divisional applications. New claims 19-20 are added. The Title and Abstract are also amended in response to the Examiner's objections. In view of the foregoing amendments and following remarks, it is respectfully submitted that the application is in condition for allowance. Reconsideration is respectfully requested.

### **II. TITLE AND ABSTRACT**

By this Amendment, the Title is hereby amended to read as follows: "MEASURING DEVICE AND METHOD FOR VERIFYING THE CUT QUALITY OF A SHEET USING IMAGE SCANNING." Reconsideration is respectfully requested.

By this Amendment, the Abstract is replaced to conform with the requirements set forth in M.P.E.P. § 608.01(b). Reconsideration is respectfully requested.

### **III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

On pages 2-3 of the Office Action dated January 10, 2008, claim 13 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action states that the recitation of "preferably 1200 dpi . . . is not a positive recitation." In response, the Applicant has removed this language from claim 13 thus rendering the rejection moot. New claim 19 is added to recite the resolution of approximately 1200 dpi. Claim 19 depends from claim 13. Consideration is respectfully requested.

### **IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

On pages 3-4 of the Office Action, claims 1-3, 6, 10-12, 15, and 18 are rejected under 35

U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0133022 to Morita. The rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); see M.P.E.P. § 2131. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Here, it is respectfully submitted that Morita fails to teach or suggest each and every element as set forth in the claims.

Amended claim 1, for example, recites:

A measuring device for testing the cut quality of a sheet, comprising:  
a transparent scanning substrate for holding the sheet,  
a scanning device defining a scanning window in a region of the scanning substrate, and  
a cover for covering the sheet held by the scanning substrate, wherein the scanning window overlaps the sheet, forming edge regions, and ***the cover has different reflection properties from the sheet*** for producing a high-contrast scanned image of the sheet and of the edge regions between the sheet and the scanning window. (emphasis added).

Thus, amended claim 1 recites that "the cover has different reflection properties from the sheet for producing a high-contrast scanned image of the sheet and of the edge regions between the sheet and the scanning window." Claim 10, as amended, similarly recites the method step of "covering the sheet with a cover, wherein the cover has different reflection properties from the sheet."

The Office Action cites Morita, in particular original feeder 12 and scanner unit 21 as shown in Figure 1, as teaching or suggesting each and every element in at least claim 1. The Applicant respectfully disagrees. Morita relates to "an image forming apparatus such as a LBP (laser beam printer) or a copying machine that uses electronic photographic technology, for example, and an image formation control method." Paragraph 0002. More specifically, Morita purportedly discloses an "image forming apparatus main body 10" including "an image reader 11 for reading images of originals, and a printer 13." Paragraph 0067. With reference to FIG. 1, Morita further states:

In the image reader 11, an original feeder 12 is mounted. The original feeder 12 feeds originals, which are set face up on an original tray 12a, one by one in turn from the top page to the leftward direction in the figure, conveys each original onto a platen glass through a curved path, and stops the original at a predetermined location, and then, by causing a scanner unit 21 to scan the original from the left to the right in this state, the original is read. Paragraph 0068.

The printer 13, which is separate from the image reader 11 and original feeder 12, includes various features "capable of accurately detecting the position of a sheet in the sheet feeding direction to thereby obtain an accurate printing position" and "capable of accurately detecting skew of a sheet before formation of an image on the sheet to thereby prevent a sheet with an image formed with a low print quality due to skew of the sheet from being output." Paragraphs 0010 and 0011. Notwithstanding these features and capabilities, it is respectfully submitted that Morita fails to teach or suggest a cover having different reflection properties from the sheet as recited in at least claims 1 and 10. That is, the original feeder 12 of Morita, which the Office Action indicates as corresponding to the recited "cover," does not have such reflection properties. In fact, if the scanning unit 21 of Morita's image forming apparatus 10 irradiated with light an area greater than that defined by the sheet, and the reflective properties of the original feeder 12 differed from the sheet to be scanned, undesirable marks would likely result on the printed copy output by the printer 13. This would defeat the purpose of Morita which is to improve the quality of printed sheets output from a laser beam printer or copying machine.

Accordingly, it is respectfully submitted that at least claims 1 and 10 are allowable over Morita. Claims 2-9 depend variously from claim 1 and are submitted as being allowable for at least the same reasons. Claims 11-17 and new claim 19 depend variously from claim 10 and are submitted as being allowable for at least the same reasons. Reconsideration and withdrawal of the rejections are respectfully requested.

#### **V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

On pages 4-5 of the Office Action, claims 4, 5, 7-9, 13, 14, 16, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita. The rejection is respectfully traversed. As noted above, Morita fails to teach or suggest a cover having different reflection properties from the sheet. It is also respectfully submitted that it would not have been obvious to modify

the original feeder 12 of Morita, for example, to have different reflection properties from the sheet because this would run counter to the objects of Morita. The statements in the Office Action that it would have been obvious to modify the conveyor of Morita's original feeder 12 "based on its suitability for the desired conveyance means" or "to control the movement/position of the sheet in a particular manner" etc., are not believed to be factually based nor are they believed to be based on any substantive reasoned analysis as to how or why Morita would be so modified. Pursuant to *KSR Int'l v. Teleflex, Inc.*, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." 550 U.S. \_\_\_, 82 USPQ2d 1385, 1386 (2007). The conclusory statements in the Office Action are not believed to be sufficient to support an obviousness determination. Accordingly, at least claims 4, 5, 7-9, 13, 14, 16, and 17 are believed to be allowable. Reconsideration and withdrawal of the rejection are respectfully requested.

#### **VI. NEW CLAIMS 19-20**

By this Amendment, new claims 19 and 20 are added. As noted above, claim 19 depends from claim 13 and includes a recitation of the resolution as being approximately 1200 dpi. Claim 20 is added to more particularly recite the features of the measuring device for testing the cut quality of a sheet. Support for the recitations in new claim 20 is believed to be provided on pages 4-5 of the originally filed disclosure as well as in FIGS. 1 and 2. Consideration is respectfully requested.

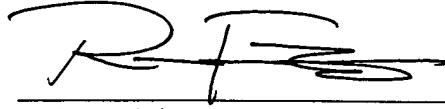
#### **VII. CONCLUSION**

All of the stated grounds of objection and rejection are believed to have been properly overcome, traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. An early notice to that effect is respectfully requested.

The Examiner is respectfully requested to contact Applicant's undersigned Representative if necessary to place the application in condition for allowance.

Prompt and favorable consideration on the merits is respectfully requested.

Respectfully submitted,



Dated: April 10, 2008

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